

REMARKS/ARGUMENTS

By the present amendment, no claims have been added, cancelled, or amended. Accordingly, claims 1 – 40 are presently pending, and favorable reconsideration thereof is respectfully requested. Claims 1, 5, 21 and 36 – 40 are the independent claims.

Applicants note with appreciation the acceptance of the formal drawings as originally filed. Applicants also note with appreciation the indication that claims 9 and 24 would be allowable if re-written in independent form.

The Examiner has rejected claims 1 – 8, 10 – 23 and 25 – 40 under 35 U.S.C. § 102(b) as being anticipated by Celler (“An EM-algorithm for dynamic SPECT tomography”, March, 1997). This rejection is respectfully traversed and reconsideration is respectfully requested.

The full citation of the Celler reference, which was listed as reference number “AR” on Applicants’ Information Disclosure Citation form filed November 16, 2000 (a copy of which the Examiner attached to the present Office Action) is as follows:

H. H. Bauschke, D. Noll, A. Celler and J.M. Borwein, “An EM-algorithm for dynamic SPECT tomography”, CECM (Simon Fraser University) Internal Research Report 997-092, March, 1997.

[emphasis added]

For convenience of terminology, the cited Celler reference is referred to herein as the “Celler Internal Research Report”.

Applicants respectfully submit that the Celler Internal Research Report is not citable prior art pursuant to 35 U.S.C. § 102(b), because it was confidential at all material times and was therefore not a “publication.” Evidence and arguments to that effect are discussed in greater detail below.

As a preliminary matter, with respect to the effective filing date of the present application for the purposes of 35 U.S.C. § 102(b), Applicants respectfully note that the present application has been accorded an official filing date of **November 5, 1999** (as indicated on the Official Filing Receipt for this application), rather than the February 15, 2000 date indicated on

the Office Action. In addition, the present application claims the benefit of priority from United States provisional application serial no. 60/107,335 filed **November 6, 1998**, as indicated on page 1 of the present application and in the Declarations and Powers of Attorney as originally filed. Thus, the effective filing date of the present application is the U.S. provisional application filing date of November 6, 1998 (see e.g. M.P.E.P. § 706.02.V.(D) and 35 U.S.C. § 119(e)). Accordingly, for the purposes of 35 U.S.C. § 102(b), the critical date at which the one-year grace period commenced was one year prior to the effective filing date, i.e., **November 6, 1997** (see e.g. M.P.E.P. § 2133).

In the present case, the Celler Internal Research Report was an early draft of a paper that was ultimately published in March, 1999, namely, reference “AA” indicated on Applicants’ Information Disclosure Citation form filed November 16, 2000, whose full citation information is as follows:

H. H. Bauschke, D. Noll, A. Celler and J.M. Borwein, “An EM Algorithm for Dynamic SPECT”, *IEEE Transactions on Medical Imaging*, Vol. 18, No. 3, March, 1999, pp. 252-261.

However, the latter published paper (hereinafter referred to as the “IEEE Publication”) is not citable prior art against the present application, as its March, 1999 publication date is well after the critical citability date for the purpose of 35 U.S.C. § 102(b).

Returning to the Celler Internal Research Report itself, Applicants’ patent agents and patent attorneys included both the Celler Internal Research Report and the IEEE Publication in the Information Disclosure Citation form dated November 16, 2000 out of an abundance of caution, to ensure compliance with Applicants’ duty of candor. However, 37 C.F.R. § 1.97(h) provides that, “The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).” Thus, the mere inclusion of the Celler Internal Research Report in the Information Disclosure Citation form, for the purpose of ensuring compliance with Applicants’ duty of candor, is not an admission that it constitutes citable prior art against the present application.

Applicants enclose two Declarations, one from Anna Celler and one from Dominikus Noll, both of whom are named as co-inventors of the present application, and both of whom are named as co-authors of the Celler Internal Research Report. Applicants respectfully submit that the enclosed Declarations demonstrate that the Celler Internal Research Report was confidential at all material times, and hence was not a "printed publication" pursuant to 35 U.S.C. § 102(b).

With respect to the applicable legal principles relating to citability of internal documents intended to be confidential, Applicants respectfully agree with the following summary in M.P.E.P. § 2128.01.III:

**III. <INTERNAL DOCUMENTS INTENDED TO BE
CONFIDENTIAL ARE NOT "PRINTED PUBLICATIONS"**

Documents and items only distributed internally within an organization which are intended to remain confidential are not "printed publications" no matter how many copies are distributed. >There must be an existing policy of confidentiality or agreement to remain confidential within the organization. Mere intent to remain confidential is insufficient.< *In re George*, 2 USPQ2d 1880 (Bd. Pat. App. & Inter. 1987) (Research reports disseminated in-house to only those persons who understood the policy of confidentiality regarding such reports are not printed publications even though the policy was not specifically stated in writing.); ...

In the present case, each of the enclosed Declarations indicates in paragraph 4 that the Celler Internal Research Report was prepared in association with the Center for Experimental and Constructive Mathematics (which was identified as "CECM" on Applicants' Information Disclosure Citation form dated November 16, 2000). In paragraph 5, each of the enclosed Declarations indicates the inventors' understanding that the policy of the CECM was to maintain internal research reports confidential until their contents had otherwise been published by the authors, and that in accordance with this policy, the Celler Internal Research Report was maintained confidential by the CECM, until after it had been otherwise published by the authors (e.g., in the March, 1999 IEEE Publication). In paragraph 6, the enclosed Declarations further indicate that to the best of the declarants' knowledge, the Celler Internal Research Report was not made available to the public prior to the critical date for the purposes of 35 U.S.C. § 102(b).

Accordingly, Applicants respectfully submit that the above-quoted legal principles summarized in M.P.E.P. § 2128.01.III apply squarely to the evidence presented in the enclosed Declarations, with the result that the Celler Internal Research Report was confidential at all material times and was therefore not a "printed publication" within the meaning of 35 U.S.C. § 102(b).

Applicants therefore respectfully submit that the Celler reference cited by the Examiner does not constitute citable prior art pursuant to 35 U.S.C. § 102(b), and respectfully request that this ground of rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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